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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,740	06/27/2003	Simen Shagalov	P/4342-3	7755

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EXAMINER

REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,740

Applicant(s)

SHAGALOV, SIMEN

Examiner

David C. Reese

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

- [1] Claims 1-17 are pending.

Claim Rejections - 35 USC § 102

- [2] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- [3] Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman, US Patent 6,112,552.

Hoffman teaches of a gemstone setting and method of using.

As for Claim 1, Hoffman discloses a gemstone setting comprising:

a precious stone (16 in Fig. 4) having a visible upper surface (50 in Fig. 4) and a body extending below the upper surface (54 in Fig. 4), the body having facets that meet to form

corners, each facet having a groove at each corner that extends from the corner along only a portion of the facet so that the grooves of the facets that form each corner meet at the corner (26 in Fig. 3).

As for Claim 3, Hoffman shows a gemstone setting, wherein the grooves in the diamond are effective for enabling the diamond to be invisibly mounted (Claim 6 of Hoffman).

[4] Claims 1-17 are rejected under 35 U.S.C. 102(e(1)) as being anticipated by Ubhayakar US-2003/0056536 A1.

Ubhayakar makes known a princess cut invisible stone setting.

As for Claim 1, Ubhayakar makes known a princess cut invisible stone setting comprising:

a precious stone (2 in Fig. 3c) having a visible upper surface (top of 2 in Fig. 5) and a body extending below the upper surface (bottom of 2 in Fig. 5), the body having facets that meet to form corners, each facet having a groove at each corner that extends from the corner along only a portion of the facet so that the grooves of the facets that form each corner meet at the corner (6 in Fig. 3c).

As for Claim 2, Re: Claim 1, Ubhayakar makes known a princess cut invisible stone setting, wherein the precious stones are diamonds (Paragraph [0024] stating, "A preferred embodiment of the present invention utilizes a diamond for the stone).

As for Claim 3, Re: Claim 2, Ubhayakar makes known a princess cut invisible stone setting, wherein the grooves in the diamond are effective for enabling the diamond to be invisibly mounted (paragraph [0009], stating "perpendicular supports for the upwardly extending

support brackets are below the diamonds and completely invisible when viewing the table. Thereby achieving an invisible setting”).

As for Claim 4, Ubhayakar makes known a princess cut invisible stone setting, comprising:

a plurality of precious stones (2 in Fig. 5), each of the stones having a visible upper surface (top of 2 in Fig. 5) and a body extending below the upper surface (bottom of 2 in Fig. 5), the body having facets that meet to form corners, each facet having a groove at least one of its corners, the groove extends from the corner along only a portion of the facet so that the grooves of the facets that form each corner meet at the corner (6 in Fig. 3c); and a setting in which the stones are mounted (8 in fig. 5), the setting including prong members having an upper end (5 in Fig. 3c) and a lower end (3 in Fig. 3c), a notch being provided along an outer periphery (below 5 in Fig. 3c) of each prong member in a region of the upper end so as to form an upper edge (5 in Fig. 3c), the groove in at least one corner of each stone (6 in Fig. 3c) being engaged by the upper edge of one of the prong members (5 in Fig. 3c).

As for Claim 5, Re: Claim 4, Ubhayakar makes known a princess cut invisible stone setting, wherein the prong members are arranged to form a pattern (3 in Fig. 5).

As for Claims 6-9, Ubhayakar teaches of a princess cut invisible stone setting, wherein the stones are princess-cut diamonds (from paragraph [0024], stating, “a preferred embodiment of the present invention utilizes a diamond for the stone. A most preferred embodiment utilizes a princess cut diamond as the stone. However, various other embodiments incorporate all other semi-precious and precious stones. Generally, the present invention is designed for the setting of any stone in which the user desires an invisible setting.”)

As for Claim 10, Re: Claim 4, Ubhayakar teaches of a princess cut invisible stone setting, wherein the prong members are cylindrical (3 from Fig. 3c of Ubhayakar compared with the applicant's 9 in Fig. 12).

As for Claim 11, Re: Claim 4, Ubhayakar makes known a princess cut invisible stone setting, wherein the setting includes a body having a base (8 in Fig. 5) and two parallel sidewalls extending from the base as to form a channel (3, just the outside two in Fig. 5), the prong members being arranged in the channel so as to form a desired pattern and engage with the grooves in the stones (3, just the middle one in Fig. 5).

As for Claim 12, Re: Claim 11, Ubhayakar makes known a princess cut invisible stone setting, wherein some of the prong members are arranged on the base so as to be free standing (3, just the middle one in Fig. 5) and others of the prong members are arranged along the sidewalls (3, just the outside two in Fig. 5).

As for Claim 13, Re: Claim 11, Ubhayakar makes known a princess cut invisible stone setting, wherein the prong members are arranged along the sidewalls (3, just the outside two in Fig. 5).

As for Claim 14, Re: Claim 11, Ubhayakar makes known a princess cut invisible stone setting, wherein each of the sidewalls has a longitudinally extending groove in an interior of the channel (3, just the outside two in Fig. 5), the prong members being arranged on the base in a free-standing fashion (3, just the middle one in Fig. 5), the stones engaging in the notches of the prong members and in the grooves in the sidewalls (the process by which the stones (2) are engaged into the prong members (3) via 6, Fig. 5).

As for Claim 15, Ubhayakar makes known a princess cut invisible stone setting having facets that form corners, comprising the steps of:

forming grooves in each corner of each of the stones so that each groove extends from the corner along only a portion of the facet and meets a groove in an adjacent facet at the corner (6 in Fig. 3b);

providing a setting including prong members having an upper end and a lower end (5 and 3 respectfully in Fig. 3c), and a notch provided along an entire outer periphery of the prong member (below 5 in Fig. 3c) in a region of the upper end so as to form an upper edge (5 Fig. 3c); and

inserting the precious stones in the setting so that the upper edges of the prong members engage the grooves in the comers of the stones (the process by which the stones (2) are engaged into the prong members (3) via 6, Fig. 5).

As for Claim 16, Re: 15, Ubhayakar makes known a princess cut invisible stone setting, wherein the precious stones are diamonds (Paragraph [0024] stating, "A preferred embodiment of the present invention utilizes a diamond for the stone").

As for Claim 17, Re: 15, Ubhayakar makes known a princess cut invisible stone setting, wherein the precious stones are mounted in a manner which obtains invisibly mounted precious stones (paragraph [0009], stating "perpendicular supports for the upwardly extending support brackets are below the diamonds and completely invisible when viewing the table. Thereby achieving an invisible setting").

Conclusion

[5] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: Muller, U.S. Patent 5,419,159; Ramot, U.S. Patent 5,123,265; Aich, U.S. Patent 4,738,240; Giladi, U.S. Patent US 2004/0182110 A1; Gurevich et al., U.S. Patent 6,003,335; Avril, U.S. Patent 6,453,700 B1; Ambar, U.S. Patent 5,437,167.

[6] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (703) 305-0590. The examiner can normally be reached on 7:30 am - 5:00 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ROBERT J. SANDY
PRIMARY EXAMINER

Sincerely,
David Reese
Assistant Examiner
Art Unit 3677